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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/685,077
Filing Date: October 06, 2000
Appellant(s): BILIBIN ET AL.

Marilyn R. Khorsandi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 21, 2006 appealing from the Office action mailed March 13, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/684,861 Appeal Brief filed 8/30/2006, Examiner's Answer mailed 11/29/2006

09/680,654 Appeal Brief filed 8/31/2006, Examiner's Answer mailed 11/30/2006.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

NEW GROUND(S) OF REJECTION

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-62, 66, 70,71,72 and 73 are rejected under 35 U.S.C. 101 because the claims do not limit any process step to any specific machine/apparatus or transformation of an article. The machine or transformation test is a two-branch inquiry; an applicant may show that a process claim satisfies 101 either by showing that his claim is tied to a particular machine or by showing that his claim transforms an article. Furthermore, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See *In re Bilski*)

In the claims listed above, the limitation of receiving data from a first computer of a plurality of computers is simply collecting or gathering data to be processed. Therefore the step of collecting data is simply insignificant extra solution activity since it does not impose any meaningful limits on the claim.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 58, 59, 70 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholls et al. (5,485,369).

With respect to Claims 1-5, 58, 59, 70 and 72: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to (column 4, lines 8-24, and columns 15-27) collect parcel specifications, such as weight and dimensions (Figures 4A and 4B), and determines a dimensional weight (Columns 21 and 22, line 65), the examiner considers this to be a dimensional calculation rule, due to the fact that it calculated the dimensional rate, according to the carriers specifications. Nicholls then calculates rates for the shipment (column 5, lines 34-40, columns 25 and 26, line 39) based on either the dimensional weight. The examiner considers this to be a billable weight calculation rule, due to the fact that it uses the dimensional weight to calculate the rate charged to the user, therefore considered to be billable weight. Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45) by a

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shipper, where the shipper has a unique ID (See Columns 17 and 18, Table II-continued).

Nicholls discloses the system can be used for multiple parcels (Column 8, lines 18-26)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 71, 73, 78 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. in view of Kara et al. (6,233,568).

Nicholls, as disclosed above for claims 1-3, 70, and 72 discloses the use of calculating rates for multiple carriers, but discloses the automatic selection of the carrier, and fails to disclose displaying all of the rates to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See

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Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. See Kara, column 22.

Claims 6, 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls in view of Barns-Slavin et al. (5,995,950).

With respect to Claims 6, 60-61: Nicholls, as disclosed above, for claims 1 and 58, discloses the use of a shipping management system, which uses the dimensional weight to calculate shipping rate of a package. The dimensional weight rate then being the billable rate. Nicholls, fails to disclose determining if the dimensional weight exceeds the carrier's dimensional weight limitations and calculating the rates for carriers, which are capable of shipping the weight of the package (Column 1, lines 34-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Nicholls, to include the carrier's weight restriction in the rate calculations, in order to factor in the carrier's capability to ship the items, into the calculated rate. See Barns-Slavin, Column 1.

Claims 62, 66, 74 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls in view of Jenson (5,331,118).

With respect to Claims 62, 66, 74 and 79: Nicholls discloses the use of a rate system, where the billable weight is calculated with respect to the dimensional weight. Nicholls however fails to

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disclose the billable weight of the parcels being based on the physical weight. Jensen discloses the dimensional weight and the actual weight is collected, then compared, and which ever weight is the greatest, then calculating the billable rate, based on the largest rate, therefore allowing for the billable weight to be the actual weight (Jensen, Abstract, Column 1, lines 16-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls, to include the possibility of using either the dimensional rate or the physical weight of an item, in order to allow not online the weight, but the size of an item to be factored into the shipping cost, (See Jensen Column 1)

(10) Response to Argument

With respect to **Issue 1a** , Claims 1-5 being anticipated by Nicholls: Claim 1 is considered to be the broadest claim. The following is Claim 1, mapped out with how each feature reads on the Nicholls reference:

1. A shipping management computer system (**see abstract**), comprising at least one computer device (**See Figure 1**), wherein said shipping management computer system is programmed to (**Column 4, lines 8-24 and Columns 15-27**):
 - a. Receive, via a first remote user client computer device of a plurality of remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising first set of parcel specifications for a first parcel (**Figures 4A and 4B**), wherein the shipping management computer system is operable to associate a first user-specific origin identifier is with the first user (**See Zip code, Figure 4A with corresponding detailed description**), wherein the first user accesses the shipping management computer system via a global communications network via the first remote user client computer device (**Column 3, lines 38-45**), and wherein the first set of parcel specifications comprises a first set of physical dimensions of the first parcel and a first physical weight of the first parcel (**See Figure 4A and Figure 4B**); and
 - b. In response to the first input:
 - i. Apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific

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dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel
(Columns 21 and 22, line 65, the examiner considers this to be a dimensional weight calculation rule, due to the fact that it calculated the dimensional rate according to carriers specifications, Nicholls discloses each carrier having a set of shipping requirements and predetermined rate structure, therefore rules, column 2, lines 17-19 and column 4, lines 49-55 and claim1)

- ii. Apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (b.i.), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight from a group consisting of: the physical weight of the first parcel, and a respective carrier-specific letter weight. **(Nicholls then calculates rates for the shipment in Column 5, lines 34-40, columns 25 and 26, line 39, based on either the dimensional weight and delivery date. The examiner considers this to be a billable weight calculation rule, due to the fact that it uses dimensional weight to calculate the rate charged to the user, therefore considered to be billable weight.)**

The appellant states that there is no disclosure in Nicholls that Nicholls calculates a dimensional weight, much less that it calculates a dimensional weight for each carrier. As stated above, Nicholls discloses the carrier's each having rules for calculating rates, and clearly discloses in the table which variables are used to calculate rate, the dimensional weight (DIMWT) is calculated. Therefore it is the examiner's position that Nicholls does disclose calculating a dimensional weight for each carrier. The appellant has stated that even though the recitation of DIMWT is in the table, it does not disclose that the value has been calculated. Nicholls discloses user input, where the user inputs the dimensions and that weight. Nowhere does the user enter the dimensional weight, therefore the dimensional weight must be calculated.

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It is the examiner's position that the sample table of Nicholls, constitutes a disclosure that the table is fully capable of being populated by Nicholls. Nicholls discloses that the rates for one package is calculated for each carrier, and the lowest carrier is chosen. The Table is one that is used for the carriers to calculate rates, therefore it is fully anticipated that Nicholls discloses calculating the dimensional for each carrier.

The appellant has also argued that even assuming that Nicholls populates DIMWT, there is no disclosure that it would do so in response to a first input (of parcel specifications. Nicholls discloses the user enters in parcel specifications. The table of Nicholls is used to determine the rate. The rate cannot be calculated without first knowing the parcel specifications, therefore the table cannot be populated with out first obtaining the parcel specifications and the table would be populated in response to a user entering in the parcel specifications.

The appellant has argued that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules. Nicholls discloses the use of rate servers for each carrier, therefore each rate server is used for a different carrier, and each rate is calculated according to that carrier. Table II is an example of rules, or fields which are used to calculate rates for all the carriers. Table II includes a dimensional weight. Therefore with the combination of cited sections, then it is the examiner's position that Nicholls discloses calculating dimensional weight for each carrier of a plurality of carrier, in response to an input of parcel specifications.

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With respect to **Issues 1b and 1c**: It should be noted that the same arguments are presented for both Issue 1a and 1b, in terms of the Nicholls reference, therefore the arguments in terms of these issues are the same as stated above.

The appellant states that there is no disclosure in Nicholls that Nicholls calculates a dimensional weight, much less that it calculates a dimensional weight for each carrier. As stated above, Nicholls discloses the carrier's each having rules for calculating rates, and clearly discloses in the table which variables are used to calculate rate, the dimensional weight (DIMWT) is calculated. Therefore it is the examiner's position that Nicholls does disclose calculating a dimensional weight for each carrier. The appellant has stated that even though the recitation of DIMWT is in the table, it does not disclose that the value has been calculated. Nicholls discloses user input, where the user inputs the dimensions and that weight. Nowhere does the user enter the dimensional weight, therefore the dimensional weight must be calculated. It is the examiner's position that the sample table of Nicholls constitutes a disclosure that the table is fully capable of being populated by Nicholls. Nicholls discloses that the rates for one package are calculated for each carrier, and the lowest carrier is chosen. The Table is one that is used for the carriers to calculate rates, therefore it is fully anticipated that Nicholls discloses calculating the dimensional for each carrier.

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table cannot be populated without first obtaining the parcel specifications and the table would be populated in response to a user entering in the parcel specifications.

The appellant has argued that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules. Nicholls discloses the use of rate servers for each carrier, therefore each rate server is used for a different carrier, and each rate is calculated according to that carrier. Table II is an example of rules, or fields which are used to calculate rates for all the carriers. Table II includes a dimensional weight. Therefore with the combination of cited sections, then it is the examiner's position that Nicholls discloses calculating dimensional weight for each carrier of a plurality of carrier, in response to an input of parcel specifications.

With respect to **Issue 2**, Claims 7, 71, 73, 78 and 83: The appellant has stated that because these claims ultimately depend from the independent Claims 1, 2, 3 and 58, that for reasons stated in Issue 1, the claims are patentable. The examiner considers Nicholls to anticipate all the claimed limitations, as stated above, therefore for reasons stated above the examiner does not consider the claims patentable over Nicholls.

The appellant argues that Kara discloses a system that requires that a user first pre-select a class and/or delivery urgency, before displaying the rates. The claims however, recite the system to generate an online comparison display of the service-specific, carrier-specific shipping rates, which Kara does. Nowhere in the claim does it state that there is no user interaction for the rates to be displayed. Nor does it claim that all rate for all services for all carriers have to be displayed at one time. Kara discloses the capability of displaying multiple rates for multiple

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carriers at one time, and discloses the capability of calculating rates for each service of each carrier. Therefore, the examiner considers Kara to display the rates, as claimed, in claims 7, 71, 73, 78 and 83.

With respect to **Issue 3**, Claims 6 and 60-61: The appellant has stated that there is no disclosure in Barns-Slavin of calculating a shipping rate for each delivery service offered by a carrier, or of comparing a dimensional weight of a particular parcel to a dimensional weight limitation for a particular carrier. It should be pointed out that Barns-Slavin is not used to show the calculation of a shipping rate for each delivery service of each carrier. Barns-Slavin is also not used to show the display of rates. Barns-Slavin is merely used to show the limitation “if the dimensional weight exceeds the carrier’s dimensional weight limitations, then calculating the rates for carrier’s who are capable of shipping the weight of the package”. Claim 6 recites determining whether the respective carrier-specific dimensional weight of the second parcel, exceeds a dimensional weight limitation. Barns-Slavin discloses determining whether the dimensional weight exceeds a weight limitation. The fact that Barns-Slavin determines the limitation for discount purposes, or for other purposes or reasons, does not mean it does not meet or obviate the claim limitations. Furthermore, a carrier would not ship a package that it was not capable of shipping, therefore would not rate a package it was not capable of shipping. Therefore the claim limitation is rendered obvious over the prior art of record. Therefore appellant’s arguments are not considered persuasive.

With respect to **Issue 4a**, Claims 62, 66, 74 and 79: the appellant has stated that there is no disclosure in Barns-Slavin of calculating a shipping rate for each delivery service offered by a carrier or of comparing a dimensional weight of a particular parcel to a dimensional weight

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limitation for a particular carrier. This argument has already been responded to in Issue 3, see above for response. The appellant stated that Jensen fails to disclose “applies a respective set of carrier-specific dimensional weight calculation rules for each respective carrier of a plurality of carriers to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight. However, Jensen is not used to show this limitation. Jensen is merely used to show the comparison of dimensional weight and actual weight and taking the largest weight to calculate rates. The examiner considers Jensen to disclose this limitation, therefore the argument is not considered persuasive.

With respect to **Issue 4b**, Claims 62 and 66: the appellant has stated that because Claim 58 is patentable over Nicholls, then Claims 62 and 66 are therefore also patentable over Nicholls. For reasons given above the examiner does not consider the claims to be patentable over Nicholls, therefore arguments are not considered persuasive.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner’s answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

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This examiner's answer contains a new ground of rejection set forth in section above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

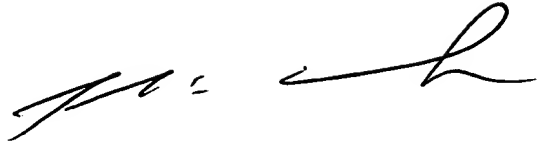
Jamisque A. Webb

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/Jamisue A. Webb/

Conferees:

John Weiss



Vincent Millin


Applied Practice
Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section above by signing below:

Wynn Coggins

Director TC 3600

